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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,277

04/21/2005

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08/14/2008

EXAMINER

KAVANAUGH, JOHN T

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

08/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,277	<b>Applicant(s)</b> DROLLINGER ET AL.	
	<b>Examiner</b> /Ted Kavanaugh/	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 6-10, 12-22, 28-43, 57 and 60-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11, 23-27, 44-56, 58-60, 63-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-18-2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8-1-2008 has been entered.

### ***Election/Restrictions***

2. Claims 6-10,12-22,28-43,57,60-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 23, 2007. Claim 57 recites "two different centers of curvature" which does not read on the elected embodiment (Species IV – figure 8) and therefore claims 57 and 60-62 have been withdrawn from consideration. It possible reads on the embodiments shown in figures 1 and 4.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-5,23-27,44-56,58,59,63-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "mounting element(s)" used throughout the claims is unclear. The mounting element in the elected embodiment (figure 8) is element 43 which is in shape

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of a pin as shown in figure 8 and described on page 14, line 23-24. However, throughout the claims is often pluralized (e.g. claim 1,57,64), which is not accurate, and also further defined as "forefoot mounting element" and "heel mounting element" (e.g. claim 64) and also referred to as rotating along an arc which would not be possible since it is located at the center of the arc. It would appear that perhaps applicant might be referring to the shaped supports (38 and 39), but if so, it also contradicts some of the other language used in the claims.

In claims 1 and 58, the phrase "mounting element(s) which is(are) movable with respect to a shoe upper only along an arc..." is unclear, inaccurate and indefinite. The ground engaging mounting element (support 38 or 39 – assuming this is what applicant is referring to) is also movable with the sole 1 and other features of the shoe. Also, the elements are moveable "only along arc" with respect to the center of the arc which is at the bolt 28 and not "with respect to a shoe upper" as claimed. The elements don't move along an arc with respect to the shoe upper but instead with respect to the location of the bolt (28). In claim 63, the phrase "ground engaging elements which are movable with respect to a shoe upper only..." and in claim 64, the phrase "mounting element being movable with respect to a shoe upper only..." are similarly indefinite.

In claim 58, line 4, "mounting elements" lacks proper antecedent basis inasmuch as only one was positively recited at line 2 (i.e. at least one ground engaging mounting element). Therefore, it is not clear is applicant is claiming one mounting element or two.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5,23-27,44-56,58,59,63-66 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6708426 (Erickson et al).

Erickson teaches a Sport shoe comprising a sole (16) have a ground engaging mounting elements including a forefoot mounting element (20) with downward projecting elements (spikes and cleats) and a heel mounting element (22) with downward projecting elements (spikes and cleats). The mounting elements are moveable only along an arc with respect to the ball and socket (see figure 3).

The ball and socket joint is the center of curvature located at the middle section of the shoe. The ball and socket joint engage each other in the way of a groove and tongue connection. The diameter of the chamber is slightly larger than the ball 40 and is flexible (made out of plastic material) which will permit entry of the ball (see col. 4, lines 34-64) and therefore with a sufficient amount of force will be detachable. The projecting elements in the forefoot mounting elements rotate ahead of the center point and the projecting elements in the heel mounting

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elements rotate behind the center point. The movements of the elements are restricted by the means of the ball and socket and therefore have a starting position and an end position.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

**-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”**

**--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”**

**-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.**

8. Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be

obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

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In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (In United States OR CANADA) or 571-272-1000.

/Ted Kavanaugh/  
Primary Examiner  
Art Unit 3728

TK  
August 13, 2008